

**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING
REJECTION OVER A "PRIOR" PATENT**Docket Number (Optional)
GT-4751

In re Application of: HUBBARD et al.

Application No.: 10/629,136

Filed: 29 July 2003

For: A Method for Seaming Wide Panels of EPDM Membrane to Form a Composite EPDM Roofing Membrane

The owner*, OMNOVA Solutions Inc., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term prior patent No. 6,615,892 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. The undersigned is an attorney or agent of record. Reg. No. _____

Signature

8 Nov. 2004

Date

James C. LeMay, Sr. Vice President

Typed or printed name

330/869-4250

Telephone Number

Terminal disclaimer fee under 37 CFR 1.20(d) included.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

11/17/2004 HAMEKONEN 00000012 071045 1029136

01 FC:1814 110.00 DA



Based on PTO/SB/96 (08-03)
which is approved for use through 07/31/2006.

STATEMENT UNDER 37 C.F.R. § 3.73(b)

Applicant/Patent Owner: HUBBARD et al.

Application/Patent No.: 10/629,136 Date of filing/issuance: 29 July 2003

Entitled: A METHOD FOR SEAMING WIDE PANELS OF EPDM MEMBRANE TO FORM A COMPOSITE . . .

OMNOVA Solutions Inc. , a corporation of the State of Ohio
(Name of Assignee) (Type of Assignee)

states that it is the assignee of

- the entire right, title, and interest; or
- less than the entire right, title, and interest, and the extent of its ownership interest is _____ %

in the referenced application or patent by virtue of either

an assignment from the inventor(s) of the identified application or patent, recorded in the USPTO at Reel _____, Frame _____, OR
 a chain of title from the inventor(s) of the identified application or patent to the current assignee as shown below

1. From: all inventors To: GENCORP INC.
This document was recorded in the USPTO at Reel 9608, Frame 0246, or a copy is attached. *
2. From: GENCORP INC. To: OMNOVA SOLUTIONS INC.
This document was recorded in the USPTO at Reel 010316, Frame 0057, or a copy is attached. *
3. From: _____ To: _____
This document was recorded in the USPTO at Reel _____, Frame _____, or a copy is attached.
4. From: _____ To: _____
This document was recorded in the USPTO at Reel _____, Frame _____, or a copy is attached.

Additional documents in the chain of title are listed on a supplemental sheet.

Copies of assignments or other documents in the chain of title are attached.

[NOTE: A separate copy (i.e., the original assignment document or a true copy of the original document) must be submitted to the Assignment Division in accordance with 37 C.F.R. Part 3 if the assignment is to be recorded in the records of the USPTO. See MPEP § 302.08.]

The undersigned, whose title appears below, is authorized to act on behalf of the assignee in this type of matter.

October 19, 2004

Date

330/869-4250

Telephone number

JAMES C. LEMAY

Typed or printed name



Signature

Senior Vice President

Title

SEND TO: **Commissioner for Patents**
P.O. Box 1450,
Alexandria, VA 22313-1450

If you need assistance in completing this form, call 800/PTO-9199 and select option 2.

Created (Oct-04)

* The recorded documents reference USSN 09/197,140 which is the parent of the present divisional application. The recorded assignment explicitly states that any divisional applications filed off of USSN 09/197,140 also are assigned.



FEE TRANSMITTAL for FY 2005

Effective 10/01/2004. Patent fees are subject to annual revision.

Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT **(\$)** 110.00

Complete if Known

Application Number	10/629,136
Filing Date	29 July 2003
First Named Inventor	HUBBARD, M.
Examiner Name	Haran, J.T.
Art Unit	1733
Attorney Docket No.	GT-4751

METHOD OF PAYMENT (check all that apply)

Check Credit card Money Order Other None
 Deposit Account:

Deposit Account Number
07-1045
Deposit Account Name
OMNOVA Solutions

The Director is authorized to: (check all that apply)

Charge fee(s) indicated below Credit any overpayments
 Charge any additional fee(s) or any underpayment of fee(s)
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION**1. BASIC FILING FEE**

Large Entity	Small Entity	Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1) (\$)					

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid
			-20** =	X	
			- 3** =	X	

Large Entity	Small Entity	Fee Description
1202	18	2202 9 Claims in excess of 20
1201	88	2201 44 Independent claims in excess of 3
1203	300	2203 150 Multiple dependent claim, if not paid
1204	88	2204 44 ** Reissue independent claims over original patent
1205	18	2205 9 ** Reissue claims in excess of 20 and over original patent
SUBTOTAL (2) (\$)		

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1051	130	2051 65 Surcharge - late filing fee or oath	
1052	50	2052 25 Surcharge - late provisional filing fee or cover sheet	
1053	130	1053 130 Non-English specification	
1812	2,520	1812 2,520 For filing a request for ex parte reexamination	
1804	920*	1804 920* Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805 1,840* Requesting publication of SIR after Examiner action	
1251	110	2251 55 Extension for reply within first month	
1252	430	2252 215 Extension for reply within second month	
1253	980	2253 490 Extension for reply within third month	
1254	1,530	2254 765 Extension for reply within fourth month	
1255	2,080	2255 1,040 Extension for reply within fifth month	
1401	340	2401 170 Notice of Appeal	
1402	340	2402 170 Filing a brief in support of an appeal	
1403	300	2403 150 Request for oral hearing	
1451	1,510	1451 1,510 Petition to institute a public use proceeding	
1452	110	2452 55 Petition to revive - unavoidable	
1453	1,370	2453 685 Petition to revive - unintentional	
1501	1,370	2501 685 Utility issue fee (or reissue)	
1502	490	2502 245 Design issue fee	
1503	660	2503 330 Plant issue fee	
1460	130	1460 130 Petitions to the Commissioner	
1807	50	1807 50 Processing fee under 37 CFR 1.17(q)	
1806	180	1806 180 Submission of Information Disclosure Stmt	
8021	40	8021 40 Recording each patent assignment per property (times number of properties)	
1809	790	2809 395 Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810 395 For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801 395 Request for Continued Examination (RCE)	
1802	900	1802 900 Request for expedited examination of a design application	
Other fee (specify) <u>1814 Statutory disclaimer</u>			110.00

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 110.00**SUBMITTED BY**

Name (Print/Type)	David G. Burleson	Registration No. (Attorney/Agent)	38,090	Telephone	330/869-4260
Signature	<u>David G. Burleson</u>			Date	9 November 2004

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.